

- 2 -

The Commissioner of Patents

Serial No. 10/532,138

REMARKS

Claims 1 to 21 and 24 to 29 are in the case.

Detailed Action

In the Detailed Action, the sequential paragraphs are numbered 1, 2, 3, 2, 3, 4, 5, and 6. As suggested by the Examiner in a telephone conversation, these are considered to be renumbered as 1, 2, 3, 4, 5, 6, 7, and 8. Thus, for example, the original paragraph numbered as paragraph 4 becomes becomes paragraph 6.

Election/Restrictions

In paragraph 1, election is required as between four groups of claims. First, it is noted that the claims of Group II, i.e., claims 22 and 23, were cancelled previously by the Preliminary Amendment filed at the time of U. S. national entry.

In response to the requirement in paragraph 1, applicant elects the claims of Group I, i.e., claims 1 to 21 drawn to a method.

In response to paragraph 2, this election is made with traverse.

In paragraph 2, reliance is made on PCT Rules 13.1 and 13.2.

The present application is a national entry from PCT, and there was no finding in the PCT proceedings that the claims did not satisfy the unity of invention requirements of Rule 13.1, and indeed a favourable opinion was established with respect to all the claims in the international proceedings. In this regard, it is notable too that among the references of the International Search Report in the international proceedings is U. S. 2002/124980. U. S. 6,254,724 referred to in paragraph 2 is identified in the International Search Report as being of the same family as this published U. S. patent application.

The PCT Applicant's Guide with respect to unity of invention expressly indicates in paragraph 131 that different categories of claims may be combined in an International Application, including a claim to a product and a claim to a process specially adapted for the manufacture of the product, as well as claims for a use of the product. In the present case, the claims of Group I are drawn to a method that results in the product of the claims of Group IV, and the claims of

- 3 -

The Commissioner of Patents

Serial No. 10/532,138

Group III are essentially directed to the use of the product of the claims of Group IV, as a new product (a paper sheet containing the lignocellulosic material).

The single general inventive concept or special technical feature linking the method and product claims is the identity of the compounds of formula (O).

Reconsideration is requested.

In response to paragraph 3 and the requirement for election of species, applicant elects the compound of claim 10 in response to the requirement for election of species a; and elects as the environment for species b, the first-mentioned environment, i.e., "aqueous medium".

Concerning paragraph 4, it is understood, based on the telephone discussion with the Examiner, that the aforementioned election of species, which was explained in the telephone conversation, satisfies the requirement of paragraph 4, but if something further is required, advice thereon would be appreciated.

It is likewise understood that with the election expressly made in response to paragraph 3, no response is required to paragraph 5, but if something further is required, advice thereon would be appreciated.

Applicant agrees with the assessment in paragraph 6.

The assessment in paragraph 7 appears to contradict the assessment in paragraph 6. For species a, claim 1 is generic as is claim 2 with respect to the method, and the now non-elected claim 27 is generic with respect to the product of the method. With respect to species b, applicant agrees with the assessment that claims 1, 2, and 6 to 29 are generic.

Concerning paragraph 8, this has been answered above in the response to paragraph 2.

Finally, as indicated above, all of the claims in the PCT application were held novel and inventive, and indeed a counterpart of U. S. 6,254,724, referred to in paragraph 2 of the Office Action, was indicated as being category A, i.e., cited only for technological background.

- 4 -

The Commissioner of Patents

Serial No. 10/532,138

The foregoing is fully responsive to the Office Action, and favourable action would be appreciated.

Respectfully,
THOMAS Q. HU ET AL
By:



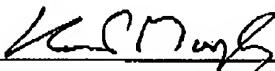
Agent for the Applicant
Kevin P. Murphy
Regis. No. 26,674
OGILVY RENAULT LLP
1981 McGill College Avenue
Suite 1600
Montreal, Quebec, Canada
H3A 2Y3
Tel. - (514) 847-4293

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

KEVIN P. MURPHY, Reg. No. 26,674
Name of person signing certification

Signature:



Date: March 7, 2007